

**REMARKS**

**I. THE EFFECTS OF THE PATENT OFFICE'S POSITION ARE VARIOUS  
ADMISSIONS CONCERNING PATENTABILITY**

The effect of the position in the official action is that the Patent Office admits that the Group I claims are patentable over a disclosure of the combination of Group II, and *vice versa*. M.P.E.P. 802.01 states that **the distinctness required for restriction means that the subjects, including "process and apparatus for its practice ... ARE PATENTABLE (novel and unobvious) OVER EACH OTHER"** (emphasis with capital letters in original). (See also M.P.E.P. 808.02, which states that where "related inventions are not patentably distinct as claimed, restriction ... is never proper." The Patent Office has also stated that "it is imperative the requirement should never be made where related inventions as claimed are not distinct." M.P.E.P. 806.)

Thus, the effect of this restriction requirement, unless withdrawn, is that the Patent Office admits that the claimed method of the Group II claim is patentable over any disclosure of an agitation mechanism for a gypsum processing apparatus according to the Group I claims. *See, e.g.*, M.P.E.P. 802.01. Likewise, the effect of this restriction requirement, unless withdrawn, is that the Patent Office admits that the claimed apparatus of the Group I claims is patentable over any disclosure of a method for agitating a gypsum based material of the Group II claims. *Id.*

These positions are necessary to entry of the restriction requirement by the Patent Office and may be relied upon by the applicants during examination of this and continuing applications, unless the restriction requirement is withdrawn. If the examiner is not taking these positions, then it is submitted that the restriction requirement should be withdrawn upon reconsideration.

II. THE STANDARD FOR REQUIRING RESTRICTION HAS ALSO NOT BEEN MET BECAUSE SEARCH AND EXAMINATION OF THE ENTIRE APPLICATION CAN BE MADE WITHOUT SERIOUS BURDEN ON THE EXAMINER

The restriction requirement is improper on its face because it does not meet the requirement that search and examination of the entire application must be a serious burden on the examiner. M.P.E.P. 803 states:

"If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

The applicants thus further traverse the restriction requirement on the ground that there is no evidence, or even allegation, that search and examination of the entire application would be a *serious burden* on the examiner, as required. A complete search directed to the subject matter of the claims of Group I would require a search directed to the subject matter of the claims of Group II, and vice versa.

Since search and examination of the entire application can be made without serious burden on the examiner, it would be wasteful of the time, effort, and resources of both the applicants and the Patent Office to prosecute these claims in separate applications. Search and examination of the two groups of claims together would be much more efficient than requiring the Patent Office and the applicants to do so separately in multiple applications:

III. PROVISIONAL ELECTION

To satisfy 37 C.F.R. 1.143, the applicants hereby provisionally elect for examination on the merits, with traverse, the claims of Group I, i.e., claims 1-34. In doing so, the applicants do not intend to abandon the scope of the non-elected claims as originally filed, but may pursue the non-elected claims in a divisional application if the restriction requirement is not withdrawn upon reconsideration.

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By:



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